

REMARKS

Applicants concurrently file herewith a Petition, and fee, for a one (1) month Extension of Time.

Claims 1-20 are all of the claims presently pending in the application. The claims have not been amended by the present Response.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino et al. (U. S. Patent No. 6,677,093; hereinafter "Yoshino") in view of Matsumura et al. (U.S. Patent No. 5,155,000; hereinafter "Matsumura") and Blair et al. (U.S. Patent No. 6,534,230; hereinafter "Blair").

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to an electrophotographic toner. The toner includes a fixing resin and a colorant. The electrophotographic toner includes a black toner using a titanium compound having no carbon black as the colorant (e.g., see Application at page 3, lines 2-21). This combination of features is important for providing a toner paying more attention to environment and safety while also being fixed at a low temperature with increased speed and reduced fixing energy (see Application at page 2, lines 9-25).

II. THE PRIOR ART REFERENCES

The Examiner alleges that Yoshino would have been combined with Matsumura and Blair to teach the claimed invention of claims 1-20. Applicants respectfully submit, however,

that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination would not teach or suggest each and every feature of the claimed invention.

As a preliminary matter, Applicants point out that the Examiner's rejection is merely directed to the claimed invention of claims 1-6, 8, 10 and 16-19. Indeed, the Examiner's rejection is merely directed to a toner using titanium oxide as a colorant (see Office Action dated October 7, 2005 at page 2). Applicants submit that the Examiner has not addressed the features of claims 7, 9, 11-15 and 20.

That is, independent claim 7 recites an electrophotographic toner, wherein "*said electrophotographic toner comprises an electrophotographic two-component black toner using magnetic iron oxide comprising no carbon black as said colorant*" (emphasis added). The Examiner's rejection has not even addressed this limitation of the claimed invention. Indeed, nowhere has the Examiner even addressed, let alone provided prior art references that teach or suggest, a two-component black toner or a two-component black toner using magnetic iron oxide.

Furthermore, regarding claims 12-15, nowhere does the Examiner's rejection even mention "an image-forming system", let alone provide a prior art reference, which is directed to an "image-forming system". In our Amendment filed on July 8, 2005, we specifically pointed this feature out to the Examiner and requested that he provide a reference that was directed to an "image-forming system". The Examiner has not responded to this particular assertion, and has again failed to address this feature in the Office Action.

Additionally, Applicants point out that the Examiners' rejection also fails to address any of the limitations recited in dependent claims 3-6, 10 and 16-19, which depend from

independent claim 1.

Therefore, if the Examiner wishes to maintain his rejection of claims 1-20, Applicants respectfully request that the Examiner specifically address each and every limitation of the claimed invention (of each claim in the Application) and provide references, which teach or suggest each and every feature of the claimed invention. Indeed, Applicants request the Examiner to provide a complete rejection of each claim of the Application in a new non-final Office Action.

Moreover, the Examiner's motivation to modify Yoshino ("to improve the flow properties of the toner" and "to improve the high volume specific resistance value of the toner") is not a problem in Yoshino that would require a solution. Furthermore, nowhere does Matsumura teach or suggest that using a metal oxide as a black colorant of a toner improves the high volume specific resistance value of the toner, as alleged by the Examiner. Therefore, a person of ordinary skill in the art, attempting to improve Yoshino, would have no reasonable motivation to consult the disparate references Matsumura and Blair, absent impermissible hindsight.

Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". That is, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP itself).

Moreover, neither Yoshino, nor Matsumura, nor Blair, nor any combination thereof, teaches or suggests that "*said electrophotographic toner comprises a black toner using a titanium compound comprising no carbon black as said colorant*", as recited in claim 1 (and similarly recited in claim 12).

Indeed, the Examiner concedes that Yoshino does not teach or suggest this feature. The Examiner states that “the use of titanium oxide as a colorant is not taught” (see Office Action dated October 7, 2005 at page 2). The Examiner merely alleges that Yoshino teaches a metal oxide as a black toner.

Applicants submit that Matsumura and Blair fail to make up the deficiencies of Yoshino. Indeed, the Examiner alleges that Matsumura teaches the use of titanium oxide in a toner with a black nigrosine or amaplast black. The Examiner attempts to rely on column 5, lines 15-30 of Matsumura to support his allegations.

Nowhere, however, in this passage (nor anywhere else for that matter) does Matsumura teach or suggest an electrophotographic toner including a black toner using a titanium compound having no carbon black as the colorant. Indeed, this passage of Matsumura merely provides a list of possible toner colorants, including carbon black. However, the list of possible toner colorants does not include a titanium compound, let alone teach or suggest a titanium compound having no carbon black as the colorant. Not only does Matsumura not teach a titanium compound as a colorant for the toner, Matsumura specifically teaches that carbon black may be used as the colorant. Therefore, Matsumura specifically teaches away from the claimed invention.

Furthermore, as indicated above, Blair fails to make up the deficiencies of Matsumura. Indeed, nowhere does Blair teach or suggest an electrophotographic toner including a black toner using a titanium compound having no carbon black as the colorant. Indeed, the Examiner does not even allege that Blair teaches or suggests this feature. The Examiner merely relies upon Blair as teaching titanium as a surface additive.

The Examiner, however, is clearly incorrect. That is, Blair merely teaches titanium

oxide having an aluminum oxide surface treatment (see Blair at column 1, lines 19-21). Blair teaches that the aluminum oxide is the surface additive, not the titanium oxide.

Thus, Blair and Matsumura clearly fail to make up the deficiencies of Yoshino.

Therefore, Applicants submit that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. CONCLUSION

In view of the foregoing, Applicants submit that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

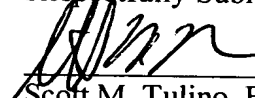
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

U.S. Application No. 10/659,271 7
Docket No. Docket No. H64-154426M/MNN
(NGB.290)

The Commissioner is hereby authorized to charge any deficiency in fees or to
credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: January 26, 2006

Respectfully Submitted,



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